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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,429

11/21/2003

Robert W. Curley JR.

22727/04199

3412

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05/10/2006

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EXAMINER

O'SULLIVAN, PETER G

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/719,429	Applicant(s) CURLEY ET AL.	
	Examiner Peter G. O'Sullivan	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-21 is/are pending in the application.
- 4a) Of the above claim(s) 6,8-10,12-15,17 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 11, 16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Claims 5-21 are pending in this application with claims 6, 8-10, 12-15, 17 and 21 held withdrawn from consideration. The rejection under 35 U.S.C. 112, second paragraph is withdrawn in view of applicants' amendment.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5, 7, 11, 16 and 18-20 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford et al., (Chem. Abst. 130:232097), and D'Ambrosio, (Chem. Abst. 134:65874), in view of Konig et al., (DE 2,300,107), for the reasons of record.

Applicants' arguments have been given due consideration but are considered non-persuasive. Clifford et al. and D'Ambrosio et al. are relied upon to disclose N-

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hydroxyphenylretinamides having antitumor and chemopreventive activities wherein the hydroxyl group may be at the ortho, meta or para positions. Konig et al. disclose the equivalency of unsubstitution to nitro, alkyl, alkoxy, etc. substitution on the phenyl moiety of similar anti-cancer retinamides.

Applicants argue no combination of references teaches or suggests using a hydroxyl and a nitro group at applicants' positions on the phenyl moiety. Konig et al., however, does teach an arylretinamide disubstituted on the aryl moiety (s. claim 4). Clifford et al. and D'Ambrosio teach a hydroxy group may be substituted in any position on the phenyl ring. Their teaching as a whole is that arylretinamides substituted at any position on the phenyl moiety by hydroxyl or one that is disubstituted by various moieties are useful as anti-cancer agents. Although applicants' argue that a certain combination of positions is not shown, there are only a limited number of positions on the phenyl moiety and in any case, applicants still claim arylretinamides substituted by nitro and hydroxyl in all positions. Applicants show how each individual reference differs from the instant invention, but under 35 U.S.C. 103, the obviousness test is whether the instant invention would have been obvious given the teaching of the references taken as a whole. In re Metcalf et al. 157 U.S.P.Q. 123.

No claim is allowed in the absence of a showing of unexpected beneficial results commensurate in scope with the claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Peter G. O'Sullivan at telephone number (571)272-0642.

PETER O'SULLIVAN  
PRIMARY EXAMINER  
GROUP 1260  
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